

The authority cited by the Examiner, e.g., *Pannu v. Storz Instruments, Inc.*, 59 USPQ 2d 1597 (Fed. Cir. 2001) requires the application of a three-step process, the first two steps which has not been conducted by the Examiner here.

Step 1 is to:

“Determine whether and in what ‘aspect’ the reissue claims are broader than the patent claims . . .”

In the instant case, the MPEP (cited above) makes it clear that the filing of “method” claims may in some cases be broader than “apparatus” claims, because they relate to manipulative steps, not structure.

Thus, the “manipulative steps” are what are broader than the apparatus structure of the patent being reissued.

Step 2 is to:

“. . . determine whether the broader aspects of the reissued claim related to surrendered subject matter” (emphasis added). Here, the “broader” aspects are manipulative steps. None of the amendments made during prosecution of the apparatus claims of the original patent, narrowed or cancelled, or otherwise surrendered manipulative steps.

Thus, the second test of Pannu fails to justify a finding that applicant cancelled “manipulative steps” in the prosecution of the original patent or that any “manipulative steps” here claimed related to surrendered subject matter of the patent allegedly being recaptured in the presently rejected claims.

The Examiner’s constant recitation of “structure,” e.g., “a vending machine having a door for retrofitting an existing vending machine” are mere dicta and have nothing to do with surrendered “broader aspects of the reissued [method] claim.”

Lastly, with regard to the Examiner’s allegations that “the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. §251,” the great weight of authority is against the Examiner; See, *In re Schripps Clinic & Research Foundation v. Genetec, Inc.*, 18 USPQ2d 1001, 1009 (Fed. Cir. 1991), citing *Balcorp v. The United States*, 221 USPQ 289, 296, n. 28, “the purpose of the reissue statute is to avoid forfeiture of substantive rights due to errors made without intent to deceive.” When the statutory requirements are met, reissuance of the patent is not discretionary with the Commissioner, it is mandatory (“shall”) citing *In re Handle*, 136 USPQ 460, 464 (CCPA 1963). According to the Examiner’s argument, no “broadening” reissue application can be filed even though the reissue statutes so direct. The courts have also stated “The failure of the attorney to claim the invention sufficiently broadly ‘is one of the most common sources of defects’” *In re Wilder*, 222 U.S.P.Q. 369 (Fed. Cir 1984), cert. denied 469 U.S. 1209 (1985) (emphasis added).

It is, therefore, requested that the Examiner withdraw his rejection under 35 U.S.C. §251 as not supported by findings of fact or operation of law.

Reconsideration of the 37 C.F.R. §1.131 Declaration of Mr. James A. Satchell, Jr. (hereinafter “Mr. Satchell’s declaration”) is respectfully requested.

The Examiner has decided that Mr. Satchell’s declaration of 10/22/04 and the Supplemental Declaration by Dora Stroud shows that “Mr. Satchell conceived of the use of a vending machine as a doorway for the public to reach websites . . .” The Examiner, without elaborating, now alleges that such declarations fail to establish conception of the invention in that the means themselves and their interaction must be comprehended also.

It is from this latter statement that applicants request reconsideration.

For example, there is no requirement that applicants describe what is already known to those skilled in the art; See, MPEP §2163(3)(a). Moreover, drawings alone may provide a written description of an invention as required by 35 U.S.C. §112, paragraph 1, MPEP, Id., citing *In re Wolfensperger*, 133 USPQ 537 (CCPA 1962), *Autogiro Co. v. United States*, 155 USPQ 697, 703 (Ct. Cl. 1967).

Here, the Satchell and Stroud declarations include drawings; supplementing those drawings originally presented in Mr. Satchell's earlier application Serial No. 08/429,583, filed August 17, 1995 or as Exhibits to the previously filed Satchell and Stroud declarations.

Those drawings collectively show a vending machine for vending a physical item, e.g., a drink, where the vending machine either directly shows, or in combination with the written description thereof, a video screen, speakers, selector buttons, a camera, microphone, motion detector, a delivery port for dispensing the item, motion lights, and internet access to the world wide web (www) through either a cable, antenna or dish; computer, laser disc, VCR, coin slots, bill receiving buttons, and a portal to connect to news, "news buttons," e.g., live news events, See, claim 1 and Section 2(2) and 7(B) of the specification of Mr. Satchell's patent application no. 08/429,583. See, also, Exhibit C (last drawing), to the Declaration of Eric P. Robins. The written description of Mr. Satchell's previous patent application provides a disclosure of many of the mundane components of a vending machine, i.e., storage compartment for articles to be dispensed, etc. However, in much more explicit detail are the teachings of dispensing videos, CD-Rom, diskettes and other such articles and internet/www access. Thus, applicants are unaware by what the Examiner urges as not disclosing the "means" themselves and their interaction.

If the Examiner is requesting applicants to know how the internet works, or what components of routers, switches, networks and other “means” make up the system known as the internet, then applicants believe the Examiner has exceeded the statutory requirements needed to implement the invention.

Very few people today understand how the internet/www is made from components or how they interrelate. However, the internet is not the invention of applicants. As noted by the Examiner, what is claimed is permitting a person (e.g., the public) access to the internet/www through a vending machine. The Examiner has conceded that Mr. Satchell has supplied sufficient evidence to support the conclusion that he conceived of that invention prior to the cited Sokal et al reference. However, the Examiner is requiring more of Mr. Satchell and his co-inventor than would be required of other applicants. The vending machine is and remains a known device. So is the internet/www. Applicants’ invention is the combination of two distinct but known separate structures into a combined unit and method to use those structures in combination.

Like a person who switches on a television set, one need not understand the circuitry of the set, the manner in which the signal is sent, the systems used to generate and transmit the signal, or even the apparatus providing electricity to the set, to use and enjoy the television.

Here, the inventors need not describe what is already known, e.g., the internet/www, its components, and interaction thereof – collectively “the means” in order to adequately describe their invention to those skilled in the art. The great number of patents issued subsequent to the filing of applicants’ patent application which matured into reissue applicants’ patent, and which carry citation of this patent, are a testament to the adequacy of the disclosure by the present applicants. To now require the present reissue applicants to now describe the structure, function and interaction of

components that form the internet/www goes way beyond the requirements of conception and/or diligence required by the patent statutes.

With regard to the specific objections of the Examiner to the previous showings of diligence as set forth in paragraphs 7-14 such are specifically addressed as follows:

7. The Examiner's allegation that paragraph 8 (of Mr. Satchell's declaration) is "primarily to marketing" is a derogatory characterization of Mr. Satchell's development of his invention and takes no cognizance of the drawings therein or written description of the use of the internet in combination with vending machines.

The Examiner wishes to characterize the purpose and ignore the content of the Exhibit, i.e., drawings and written description. This attitude prevents an objective review of the evidence presented to the Examiner.

8. Paragraph 12 of Mr. Satchell's declaration is said to contain no explanation of a "lengthy" delay between the mailing of the written description to the United States Patent and Trademark Office and the document date stamp of the United States Patent and Trademark Office thereon. Applicants are unable to explain delays in the United States Patent and Trademark Office. As shown by Exhibits A and B of the records of the United States Patent and Trademark Office (attached to the declaration of Eric P. Robins), the image file wrapper shows that on November 8, 1995, the United States Patent and Trademark Office was in possession of a specification (Exhibit B) expressly describing the use of a vending machine by a customer to access the internet/world wide web and a claim (Exhibit A) for such a process. What is more important, and overlooked by the Examiner, is that the records of the United

States Patent and Trademark Office show that it was in possession of a written description of the invention not later than November 8, 1995 and applicants are not claiming that the unaccounted delay from November 8, 1995, until the subsequent date stamping of December 26, 1995, by the United States Patent and Trademark Office is a period constituting diligence by reason of the delay. To the contrary, paragraphs 15, 16, 17, 18, 19, 20, 21, 22 and 23 all state other activities undertaken during this same period, evidence upon which the Examiner remains silent as he does on the November 8, 1995, specification and claims as filed with the United States Patent and Trademark Office.

9. As to paragraph 13, Exhibits E and F are hereby resubmitted as the Examiner has alleged the previous copies are partially illegible. The handwriting of Exhibit E is that of Mr. Satchell and reads as follows:

A CONTINUED ACT TO THE DRAWINGS SIGNED 11/8/95, STAMPED by USPTO is CHANGE OF "MUSIC VIDEO" TO "ON-LINE VIDEOS, AFFIRMATIVE ACT AFTER 11/9/95-3/19/95, FIRST LAWER READ "ON-LINE VIDEOS."

10. Paragraph 14 describes a host office. A "host office" is a term of art to mean a site (office) that performs "hosting" as that term is understood by those skilled in the world wide web and internet industry. "Web sites" are "hosted" usually, though not necessarily by an ISP (Internet service provider). As part of the applicants' diligence in bringing the invention towards a reduction to practice, the applicants were building a host office to act as the ISP to implement the invention towards an actual reduction to practice. Evidence of diligence towards an actual reduction to practice may be

tacked onto evidence showing diligence towards a construction reduction to practice. Gammeter v. Backdahl, 50 App. D.C. 45, 1920 C.D. 209 (1920). This is why steps taken to build the host office are evidence of diligence in bringing the invention towards a (constructive or an actual) reduction to practice.

11. Paragraph 15 specifically identifies 8 hours of work on the days of November 13 and November 17, 1995, with regard to the invention. To the extent that the Examiner wishes a supplemental statement, such is provided in the accompanying Supplemental Declaration of Mr. James A. Satchell, Jr. and Johnson Asumadu. Exhibit G, though making no specific mention of the contents of papers discussed in Exhibit A (to which Exhibit G refers) does allege the existence of other patents in this field which caused Mr. Satchell to search for several sources of other “alleged” internet/worldwide web vending machine patents.
12. Paragraph 18 refers to a trip Mr. Satchell made to “The World of Coca-Cola” which was a research and development trip to investigate the allegations of Coca-Cola as contained in Exhibit G that “you might be interested to know we have a similar type of multi-media interactive drink vending machine on display at The World of Coca-Cola,” and it relates to the allegation by Coca-Cola of the possible existence of prior art, e.g., “on display” in a vending machine at The Coca-Cola World.
14. Paragraph 17 and 20 refer to “animation” occurring on Friday and Saturday, December 1 and 2, 1995 and on Saturday, December 18, 1995. The animation was an attempt by Mr. Satchell to formulate a visual description of implementation of the invention. As noted in paragraph 20, Mr. Satchell did not disclose the attempt at

animation as it proved unsuccessful in visually describing the invention in a patent application.

16. The Examiner appears to conclude that the showing of diligence fails for merely a few days, i.e., October 19, 1995, November 12 and November 14-16.

Firstly, in showing diligence, not every day need be accounted for; See, Bey v. Kollonitsch, 231 U.S.P.Q. 967, 970 (Fed. Cir. 1987), and Rines v. Morgan, 116 U.S.P.Q. 145 (CCPA 1957).

Secondly, periods of inactivity can be satisfied by an explanation, without causing a failure of diligence; See, MPEP 715.07(a).

As stated at paragraph 9 of Mr. Satchell's declaration, he was resident at Tuskegee, Alabama when hurricane Opal descended thereon and as a direct result of the hurricane, Mr. Satchell and his family were without electric power (including without limitation, lights, running water, heat, sanitation, laundered clothes and other aspects of personal hygiene) from October 5th through and including October 18, 1995. After almost two weeks without power, personal hygiene and domestic activities were paramount to their existence. To the extent that the Examiner wishes to have a showing as to these activities, Mr. Satchell has included such statements in the attached Supplemental Declaration.

17. Applicants dispute the Examiner's conclusory statement that the filing of the amendment (including a substitute specification) in parent application 08/429,583 is not a constructive reduction to practice. The Examiner has cited no authority for such a conclusory statement. To the contrary, applicants submit that they can satisfy the requirements of a "constructive reduction to practice" by filing a specification describing the invention which they have in

the substitute specification in Serial No. 08/429,583. See, *Kawai v. Metlesics*, 178 USPQ 158 at 163 (CCPA 1973):

“It follows naturally from this that the written description in the application is the evidence proving the invention of that which is reduced to practice . . .”

The courts have recognized that the written description in the application is the reduction to practice. Such was the case in Mr. Satchell’s predecessor application 08/429,583. The Examiner in charge of that application made no challenge to the content of the written description.

Thus, applicants demand the present Examiner to cite authority for his proposition that the written description (including, without limitation, the drawings) in Mr. Satchell’s previous application is not evidence proving the invention of that which is reduced to practice or withdraw the criticism.

19. Applicants provide the joint declaration of inventors James A. Satchell, Jr. and Johnson A. Asumadu in response to both the request for information and in response to the issues set forth on the preceding Office Action.

RESPONSE TO REJECTIONS BASED ON “PRIOR ART”

Reconsideration of all the rejections relying in part upon Sokal et al (U.S. Patent 5,953,504), e.g., in paragraph 21, 22, 23, 24, 26 is respectfully requested.

Sokal et al is not “prior art” within the sense of 35 U.S.C. §102 and, hence, cannot be used in an rejection under 35 U.S.C. §103(a).

The Examiner has already admitted that Bradt et el (U.S. Patent 4,839,505) does not specifically teach Internet access using a vending machine.

Applicants have shown from the previously filed declarations, including the present request for information, not only conception, but also constructive reduction to practice of the invention

prior to the date of Sokal et al, but, also at least conception coupled with diligence in the entire time from just prior to Sokal et al until a constructive reduction to practice in filing the patent application which matured into the patent being reissued.

Accordingly, because Bradt is not prior art within the sense of 35 U.S.C. §102, it cannot anticipate and the rejection fails to establish a *prima facie* case of obviousness for the claimed invention.

Reconsideration of the rejection of claim 130 under 35 U.S.C. §102(b), or in the alternative, under 35 U.S.C. §103(a) as obvious over Huegel (U.S. Patent 5,239,480) is respectfully requested.

In order to be anticipatory, a single reference must teach all the recited limitations of the claim.

Here the Examiner concedes that “Huegel . . . does not specifically mention the term websites.”

The Examiner continues “These remote sites of Huegel are obviously if not inherently ‘websites.’” This allegation confuses inherency and obviousness. The authority on this issue is clear. Something that is inherent is not obvious. *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81, 88, stating “Inherency and obviousness are distinct concepts.” Thus, the obviousness rejection must fail. So too the inherency rejection must fail because not all “remote sites” are necessarily “websites.” Inherency requires inevitability. The fact that a “remote site” may be a “website” does not necessarily mean that such is always the case and, thus, inherency fails under 35 U.S.C. §102. Withdrawal of the rejections are, therefore, respectfully requested.

Reconsideration of the rejection of claim 130 under 35 U.S.C. §102(e) over Kolls (U.S. Patent 5,637,845) is also respectfully requested.

Claim 130 permits customer access to websites. This was described in both predecessor application Serial No. 08/429,583, as well as the application which matured into the patent undergoing reexamination. While Kolls may permit a credit card authorization to be transmitted via a network, there is no teaching in Kolls that discloses the steps of claim 130, “incorporating an interactive consumer accessible internet communication system into the vending machine to permit the customer access to websites.” The network communication of Kolls is not of the type claimed. No system exists in Kolls permitting a consumer to visit or access a “website.” The Examiner’s reliance on column 4, lines 27-34 is misplaced. Therein, it is suggested that “computer operated devices for on-line searching, database searching or printing may be used as a vending machine instead of a copy machine.” Neither on-line searching or database searching inherently shows the use of the internet. An “on-line service” is not necessarily a website, nor is access via the internet required to access an “on-line service.” Note, the patent being reissued uses both terms in its description (e.g., column 2, lines 16-17) in accord with the industry understanding such terms are not synonymous. In this regard, also see the contemporaneous literature of February 1996, printed in PC Computing “Online Superguide”, page 120, stating “The sudden popularity of the world wide web has galvanized online services to expand the features and improve the reliability of their client software In general, we found it as bit easier to move around with online services through Navigator 2.0 on the web, but the web’s content is far richer.” Exhibit L to previous declaration of Mr. Satchell. Again, the Examiner fails to find in the Kolls references “an interactive consumer accessible internet communication system” as recited in the claims. The absence of a teaching of such a system negates anticipation under 35 U.S.C. §102. If the Examiner is of the opinion that

“internet” or “websites” are shown in Kolls, he is requested to clearly point out the terms and not resort to obfuscation.

Withdrawal of all objections and rejections and passage of the application to issue is respectfully requested.

Respectfully submitted,



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Attachments:

Supplemental Rule 132 Declaration responding to request for information.
Declaration of Eric P. Robins

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